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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,552	08/07/2001	Linda J. McMeekin	JBP-562	2880

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EXAMINER

GHALI, ISIS A D

ART UNIT PAPER NUMBER

1615

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,552	Applicant(s) MCMEEKIN ET AL.	
	Examiner Isis Ghali	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The receipt is acknowledged of applicants' request for RCE and declaration, both filed 12/20/2004; and amendment, filed 1/27/2005.

Claims 1, 3, 4, 7, 9, 11-15 are pending and included in the prosecution.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3, 4, 7, 9 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation

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"discrete" in line 8 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 3, 4, 7, 9, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over RD 382014 A ('014) in view of WO 99/25318 ('318).

RD '014 teaches a wet or dry textured wipe for treating the skin comprising a substrate and a pattern of texture is applied to the substrate by a hot-melt printing

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technique. The textured wipe is effective at cleaning the skin. Polyolefins, polyesters and ethylene vinyl acetate are used to form the textured pattern. Area coverage, patterns, colors and thickness of the texture can be widely modified. The coverage area ranges from 1 % to 100% of the substrate area. The thickness ranges from a few millimeters to 50 millimeters. The texture resins also contain active ingredients or controlled solubility active agents. (See the provided abstract).

RD '014 does not expressly teach the material of the substrate, the diameters of the raised elements, the same exact surface area coverage range or the amount of the polyolefins in the hot melt. RD '014 does not teach the specific printing technique as claimed in claim 12. Regarding the other ingredients of the hot melt claimed in claim 4, these ingredients are optional and not required by the claim as the claim recites their amounts as low as 0%.

The diameters of the raised elements and the surface area coverage range, as well as the amount of polyolefins in the hot melt do not impart patentability to the claims, absent evidence to the contrary.

The printing techniques claimed in claim 12 are well known in the art and do not impart patentability to the claims absent evidence to the contrary.

WO '318 teaches a cleansing wipe that has superior softness, feel and cleansing properties (page 2, lines 48-50). The wipe comprises a non-woven substrate layer (page 2, line 72 -75). The average basis weight of the substrate is from about 40 to 90 grams per square meter (page 5, lines 164-173). The substrate can be impregnated by active agents (abstract).

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Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide the wipe disclosed by RD '014 for cleansing the skin that comprises substrate and raised textured pattern and use the non-woven material disclosed by WO '318 for the substrate, motivated by the teaching of WO '318 that the non-woven substrate has superior softness, feel and cleansing properties and can be impregnated by active agents, with reasonable expectation of having a wipe having non-woven substrate and raised textured pattern that can deliver a beneficial active agents to the skin of the user.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,116,563 teaches suitable hot-melt technique to be the gravure printing technique (col.5, lines 5-33).

Response to Arguments

8. Applicants' arguments filed on 01/27/2005 have been fully considered but are found not persuasive.

Applicants submit that the cited documents fail to provide the requisite motivation to combine the teachings of the cited references to achieve the claimed invention, but moreover, the cited references fail to teach or suggest the unexpected results discovered by applicants to be associated with the claimed articles having the recited

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combinations of substrate basis weights and raised element diameters. In light of such unexpected results and other arguments, the claimed invention is patentable over the cited documents. As illustrated in the Rule 132 Declaration of Joseph Luizzi, a true and correct copy of which is attached hereto, applicants have discovered significant and unexpected properties associated with the articles of the claimed invention as compared to comparable articles having combinations of substrate basis weights and raised element diameters outside of the claimed ranges.

In response to these arguments, it is the position of the Examiner that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). RD '014 reference teaches wipe having substrate and raised elements and substrate can contain an active agent. WO reference is relied upon for the solely teaching of the material of the substrate and its basis weight. Therefore, the combination of the references would suggest a texture wipe with a skin care composition loaded on the non-woven substrate having the claimed basis weight. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

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USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art to provide the wipe disclosed by RD '014 for cleansing the skin that comprises substrate and raised textured pattern and use the non-woven material disclosed by WO '318 for the substrate, motivated by the teaching of WO '318 that the non-woven substrate has superior softness, feel and cleansing properties and can be impregnated by active agents, with reasonable expectation of having a wipe having non-woven substrate and raised textured pattern that can deliver a beneficial active agents to the skin of the user. In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

The examiner ultimate conclusion is that the invention as whole is prima facie obvious over the combination of the cited prior art.

Response to Amendment

The declaration under 37 CFR 1.132 filed 12/20/2004 is insufficient to overcome the rejection of claims 1, 3, 4, 7, 9, 11-15 based upon USC 103 (a) obviousness rejection as set forth in the last Office action because: there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims since the "dynamic coefficient of friction" is not claimed or discussed in the specification. See MPEP § 716. It include(s) statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. Furthermore, the comparative data does not show the upper and lower limits of the claimed ranges, the data shows only one range somewhere in between the upper and lower ranges. The comparison should be done with only one variable in order to obtain a valuable comparative data, e.g. use only one wt. basis with different diameters, then a second wt. basis with the different diameters and so on; then the diameter stay the same and the wt. basis change, etc.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

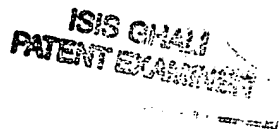
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

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ISIS GHALI
PATENT EXAMINER